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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,542	05/22/2001	Robert Alan Reeves	STEV-109	1268
7590 11/17/2004 ROBERT E. STRAUSS 74527 Moss Rose Drive Palm Desert, CA 92260			EXAMINER CHANG, VICTOR S	
			ART UNIT 1771	PAPER NUMBER

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/862,542

Applicant(s)

REEVES ET AL.

Examiner

Victor S Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 6-24 is/are pending in the application.
- 4a) Of the above claim(s) 9-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-8 and 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Introduction

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 8/10/2004. Applicants' amendments to claims 1 and 2, and new claims 20-24 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, Applicants amendment overcomes the rejection in sections 4 and 5 of Office action dated 5/13/2004. However, an additional search is required, and it yielded a new reference. The new reference is found to render obvious the instant claimed invention. Applicant's comments regarding the prior art are moot in view of the new grounds of rejection.

Claim Objections

4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

There are duplicates of claim number "19". The first misnumbered claim 19 has been renumbered 18.

Claim Rejections - 35 USC § 112

5. Claims 1, 2, 6-8 and 16-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

More particularly, in independent claim 1, the recitation “a top coat of a pressure sensitive adhesive which is substantially non-adhesive at ambient temperature and adhesive at said demolding temperature” is considered to be too broad and in excess of provided enablement in the specification, since the property recitation purports to cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart desired characteristics, but are unobvious to the instantly claimed invention. As a result, undue experimentation would be required to formulate suitable compositions for this claim or to determine what would or would not infringe. *Ex parte Slob* (PO BdApp) 157 USPQ 172. Further, the Examiner notes that, in newly added claims 16 and 17, the recitations “top coat adhesive is a hydrocarbon resin” and “backing coat adhesive is a hydrocarbon wax”, respectively, also appear to be unduly broad, since they recite a genus “hydrocarbon resin” or “hydrocarbon wax”, and fail to recite any required structure and/or chemical properties to meet the desired property, as such undue experimentation would also be required to formulate suitable compositions.

6. Claims 1, 2, 6-8 and 16-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More particularly, in independent claim 1, the recitation "a top coat of a pressure sensitive adhesive which is substantially non-adhesive at ambient temperature and adhesive at said demolding temperature" is vague, indefinite, functional, and fails to give notice as to what constitutes infringement upon the instantly claimed invention. It should be noted that claims merely setting forth physical characteristics desired in article, and not setting forth specific structure and/or compositions which would meet such characteristics, either in the claim or specification, are invalid as vague, indefinite, and functional, since it recites compounds by what it is desired that they do rather than what they are, and resulting in a claim scope that is indefinite since one of skill in the art is unable to determine without undue experimentation what compounds are included or excluded therefrom. As such, it is unclear to the Examiner as to what is the scope of the invention of which Applicant intends to claim. Ex parte Slob (PO BdApp) 157 USPQ 172.

Rejections Based on Prior Art

7. Claims 1, 7, 8, 16, 18, 19 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsura et al. (US 5223315) in view of Noguchi et al. (US 5606356).

Katsura's invention is directed to a molded container with a label (Abstract). In Fig. 1-A, Katsura shows a label 1 consists of a laminate comprising a plastic film substrate layer 2, a print layer 3 formed on the substrate layer 2 and a hot-melt adhesive resin layer 4 formed on the surface of the print layer 3 (column 7, lines 43-47). A known ink can be used for formation of the print (column 10, lines 14-20).

For claim 1, although Katsura lacks express teachings that the print layer (indicia coat) is formed of a mixture of indicia material and hydrocarbon wax, and the top coat is adhesive at demolding temperature. However, Katsura does teach that a known ink can be used, as set forth above, and it is also noted that Noguchi's invention is directed to an ink for heat transfer (column 1, line 14). Noguchi teaches that it is known art that in order to prevent running and strike-through of the ink and to keep the printed image quality by adjustment of the ink formulation, a solid component like a wax and a polymeric compound is added to the ink with the dye component (column 2, lines 7-12). As to the top coat being adhesive at demolding temperature, since the specific "demolding temperature" is absent, it is the Examiner's position that Katsura's hot-melt adhesive reads on the aforementioned limitation as claimed. As such, it would have been obvious to one of ordinary skill in the art of transfer label to modify Katsura's label with a hydrocarbon wax based ink, as taught by Noguchi, motivated by the desire to obtain an improved printed image quality. In other words, Katsura in view of Noguchi render obvious the instant invention as claimed. Finally, it should also be noted that the preamble has not been given patentable weight, because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and

the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause.

For claims 8, 18 and 19, Katsura teaches that as the plastic material constituting the vessel and label substrate film, suitable thermoplastic resins include polyethylene and polyester such as polyethylene terephthalate (PET), etc. (column 9, lines 1-17 and Table 1). Further, it should be noted that PET film is known to be inherently transparent.

For claims 7 and newly added 22, Noguchi lacks express teachings regarding the amount of hydrocarbon wax and colorant in the indicia coat. However, Noguchi does expressly teach that it is known art that in order to prevent running and strike-through of the ink and to keep the printed image quality by adjustment of the ink formulation, a solid component like a wax and a polymeric compound is added to the ink with the dye component, as set forth above. As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art of ink for heat transfer label to modify Katsura's label with a suitable amount of hydrocarbon wax and colorant in the indicia coat, as taught by Noguchi, motivated by the desire to obtain an improved printed image quality in color.

For claim 16, Katsura expressly teaches that suitable hot-melt adhesive resin include hydrocarbon resins such as ethylene/vinyl acetate copolymer, etc.

For newly added claims 23 and 24, Noguchi expressly teaches that suitable low molecular solid compounds include natural waxes such as paraffin wax, etc., which is known to be inherently transparent.

Allowable Subject Matter

8. Claims 2, 6, 17, 20 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Further, it should be noted that as allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VSC

Victor S Chang
Examiner
Art Unit 1771

11/5/2004



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